

ORIGINAL



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MMB Docket No. 1712-0001

Application of: **Jennings**

Group Art Unit: 3611

Serial No. **09/696,458**

Examiner: **L. Lum**

Filed: **October 25, 2000**

For: **After-Market Dashboard Bezel for an Automobile having a Number of Instrument Holders and Associated Method**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 27, 2004
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Paul J. Maginot

Name of person mailing Document or Fee

Paul J. Maginot

Signature of person mailing Document or Fee

September 27, 2004

Date of Signature

REPLY BRIEF ON APPEAL

~~10/06/2004 MMEKONEN 00000048 130014 09696458~~

~~01 EC:2402 20.00 DA 145.00 BP~~

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Sir:

In response to the Examiner's Answer mailed on July 27, 2004, Applicant

hereby replies pursuant to 37 CFR § 1.193. For reasons set forth more fully

~~10/07/2004 MMEKONEN 00000008 09696458~~

~~01 EC:2403~~

~~145.00 BP~~

below, Examiner has failed to produce any reliable evidence of prior invention sufficient to support her rejection of claims 26-44 and 52-61 of the above-identified patent application under 35 U.S.C. § 102(a). Therefore, Applicant requests that the Examiner's ground of rejection be overturned by the Board. Three copies of the brief are filed herewith, together with a Request for Oral Hearing under 37 CFR § 1.194 with the requisite fee under 1.17(d). Also, please provide any extensions of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

Examiner's Failure To Properly Read And Apply 37 C.F.R. § 1.105 Has
Culminated In The Examiner Making An Erroneous Conclusion Regarding The
Publication Date For The Auto Meter Flyer.

Examiner states in her Answer that her "request for information was entirely proper within the scope of 37 C.F.R. § 1.105." See Examiner's Answer, p. 6, last sentence in the penultimate paragraph). For support she cites MPEP 704.11(a)(E) regarding one type of information that an examiner can request from an **applicant**. Examiner emphatically declares her refusal to properly read and apply Rule 105 when she asserts that "Rule 56 is totally irrelevant because the application is (still) in prosecution and NOT a trial." Such a statement starkly contradicts the plain language of Rule 105. The first paragraph of Rule 105 is unambiguous:

In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application, in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, **from individuals identified under § 1.56(c), or any assignee**, of such information as may be reasonably necessary to properly examine or treat the matter... (emphasis added).

The Examiner has failed to comply with the plainly stated requirements of Rule 105 – not regarding the type of information requested, but the *sources* for the requested information. The safeguards provided by Rule 105 have now been trespassed with expected shortcomings for the evidence gleaned from this violation of the Rule.

Those persons explicitly identified in Rule 105 as sources from which an examiner may request information possess a duty towards the U.S. Patent and Trademark Office (“PTO”) that makes them credible sources of information. Additionally, these sources suffer dire consequences if they seek to enforce patents in which they did not meet their obligations of candor towards the PTO. Such consequences do not follow in the case of sources not authorized to receive requests under Rule 105, and thus, they are not as careful in their statements to an examiner. Such carelessness has transpired in this application because the hearsay statements that the Examiner relied upon for establishing a date for the cited Auto Meter flyer have been flatly contradicted by counsel for

Auto Meter's partner who supplied Auto Meter with the product about which the Examiner called Auto Meter. See Exhibit A¹.

In framing her ground of rejection for all of the pending claims, the Examiner asserts that the "supplemental product flyer distributed by "Auto Meter Products, Inc.", *printed before June 1999* (as evidenced by the title "New for '99" and statement in center of page, "Available in June!")" (emphasis added), is sufficiently reliable to establish a date of invention prior to June 1999. However, a letter received by facsimile transmission from counsel for Gauge Works² states:

Our client and its employees cannot attest to an exact date when the Auto Meter flyer was first published...With regard to the statement on the flyer, "Available in June", our client believes this statement indicated that the product was to **become available in June, 2000.** (emphasis added).

If the Board does not require that the Examiner comply with the reasonable restrictions in Rule 105, then it must evaluate the credibility of the Examiner's testimony regarding the meaning that should be attached to the ambiguous response of some unnamed employee to her request for information regarding an Auto Meter bezel "prior to June 1999" against the credibility of counsel for the

¹ Exhibit A includes the letter and the attachments sent by fax on September 24, 2004 to Applicant's counsel. No originals have been received, therefore, the quality of the attachments are poor. Gauge Works, whose counsel sent Exhibit A, is also named with Auto Meter on the Auto Meter flyer.

² Gauge Works is the company that makes the automotive accessory product depicted in the Auto Meter flyer for Auto Meter Products, Inc. The attached letter is a response from counsel for the source of these products to Applicant's request to Auto Meter and Gauge Works for information regarding the proper interpretation of the Auto Meter flyer. The need for this supplemental evidence was required by Examiner's refusal to understand how ambiguous the statements in the flyer are and this evidence must be considered by the Board. The fact that the Board must consider a letter from a non-party to the prosecution of the present application regarding the content of the document is necessitated by the Examiner's refusal to follow the rules. If the letter is not considered, then the flyer should be excluded as well.

supplier of that product to Auto Meter who states his client believes the June availability refers to June of 2000.

The fact that the request to the unnamed employee of Auto Meter is not of record in the case demonstrates the perils of ignoring the safeguards of Rule 105. Because the request was not directed to Applicant, it is not of record in the case. Therefore, the Board cannot ascertain whether the request was unambiguously directed to product information that was publicly available prior to June 1999 or that the Examiner merely thought she had made that request clear.³ Consequently, the document does not speak for itself, but must be authenticated by the Examiner. Because the Examiner ignored the restrictions of Rule 105, she has made her credibility the issue with regard to the meaning of the cited flyer. Consequently, Applicant had no choice other than to test Examiner's testimony regarding the cited flyer. The attached letter refutes the Examiner's testimony and the Board should reverse the Examiner's ground of rejection. At a minimum, the Board should remand the application for reassignment to another examiner who has not placed himself or herself at the center of the case.

The Examiner Should Have Known The Cited Flyer Was Not What She
Purported It To Be In Light Of U.S. Patent Number D 480,431

³ Of course, one reason that the request may not be of record is that it may have revealed confidential information regarding a possible date of invention. Care in preserving the confidentiality of information in an application file is emphatically noted with regard to Internet searching. See MPEP 904.02(c). Here, where the inquiry is made directly to a potential competitor or licensee, the consequences are likewise compelling for taking care of information known only to the Examiner and Applicant.

Although Examiner disavows any relevancy between the prosecution of the present case and that of the design application that resulted in the issuance of U.S. Pat. No. D 480,431 (Examiner's Answer, page 7), the relation of the two cases is undeniable by objective standards. The design application is assigned to Gauge Works, Inc., Auto Meter's supplier of the instrument bezel pictured in the cited flyer. An instrument bezel is the subject of both applications. The design application was filed on November 1, 2002. If the cited flyer was a printed publication before November 1, 1999, then it should have been cited in the prosecution of the design case. The fact that it was not cited is plain from the front of the issued design patent. Although Gauge Works' attorney may not have known of the cited flyer, his client obviously knew of it in light of the comments made in the attached letter. Since one presumes that applicants comply with their duties of candor with regard to representations before the PTO, the cited flyer must have been regarded by Gauge Works or the named inventor in the design patent as NOT being a printed publication. In fact, from the information available from the design case, the cited flyer must not have been a printed publication before November 1, 2001.

This evidence should have given the Examiner reason to pause before determining that the cited flyer was published before June 1999. As best, the testimony of the unnamed Auto Meter employee relied upon by the Examiner has been contradicted by the prosecution of the design patent. Without solid proof of the June 1999 date of publication for the cited flyer, the Examiner should not have relied upon the flyer. The examination of the present application has been

ongoing for practically four years. Final rejections should be grounded on more substantive evidence than a product flyer having no printed date of publication and no reliable corroboration that the flyer was indeed published by an objectively ascertainable date. Instead, the evidence in the PTO and in the attached letter sufficiently refutes the assertion that the flyer was published before June 1999. This is particularly true of an assertion that is only supported by some phantom at Auto Meter.

The Attached Letter and Accompanying Exhibits Do Not Support A Publication
Date Sufficient To Support The Rejection Under 102(a)

The attached letter is presented by a registered patent attorney regarding the beliefs of his client on the meaning of the cited flyer. They are more reliable than the hearsay statements of the apparition that informed the Examiner that the flyer was publicly available before June 1999. However, they do not establish a publication date of November, 1999 in light of U.S. Patent No. D 480,431. As explained above, the first page of that patent indicates that the flyer was not cited against the design application despite its obvious relation to the invention in that case. Thus, there are good grounds for determining that the flyer was not published, if ever, before November 1, 2001. That date is almost one and one half years following the filing date of the provisional application through which the present application claims priority.

At best, the letter suggests that the flyer may have been available at the SEMA show in November 1999, but it substantiates that possibility with no

proffered evidence. That is, no one is named as having personal knowledge of the flyer being distributed at or before the November SEMA show. Comments in the letter regarding ordinary course of business do not establish particular facts regarding the flyer and its publication as required to properly support a ground of rejection under 102(a).

As noted in Applicant's opening brief, a reference is proven to be a "printed publication" upon a satisfactory showing that such a document has been disseminated or otherwise made available to any member of the public. See, e.g., MPEP 2128; see also, e.g., *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed Cir. 1986). The record of this application's examination, including the attached letter, contains no evidence that any member of the public ever received the Auto Meter Flyer. To constitute "knowledge or use" under 35 U.S.C. § 102(a), the knowledge or use must be public. MPEP 2132 I. That is, a member of the public must actually receive the flyer for it to be published. The cited flyer identifies no recipient whatsoever and, even if it did, that would not constitute receipt of the flyer by the addressee. See *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956), MPEP 2128.02. Therefore, neither the document nor the attached letter demonstrates that the flyer was received by at least one member of the public.

The Court of Customs and Patent Appeals has recognized that no weight should be given to uncorroborated statements *in an affidavit* regarding prior inventions by another. See *In re Reuter*, 210 USPQ 249 (CCPA 1981). In the present application, no affidavit is at issue. Instead, the testimony to be

considered is the uncorroborated testimony of a nameless Auto Meter or the recollections of nameless Gauge Works employees. Either way, the evidence is unsubstantiated and should be disregarded as supporting a rejection of the pending claims. Even if the Examiner takes the unprecedented step of vouching for the nameless Auto Meter employee, her testimony would be rebutted by the attached letter indicating Gauge Works' understanding of the phrase "Available in June." That is the uncorroborated testimony in this matter conflicts and cannot be used to properly support a ground of rejection under 102(a).⁴

⁴ Likewise, the comments made in the letter regarding the bezel purportedly made by Mitsubishi require further investigation to determine their veracity. To name a few, the representation that the element is indeed an instrument bezel for housing automotive meters or the assertion that such a part was publicly available at the date indicated in the letter require substantiation before these documents attain the indicia of reliability that warrants their consideration. Even counsel for Gauge Works admitted that a complete investigation was required for determining the proper action to take with regard to this new revelation. A complete investigation was not possible prior to the filing of this reply brief as the letter was received by fax on September 23, 2004 and this reply brief was filed on September 27, 2004.

CONCLUSION

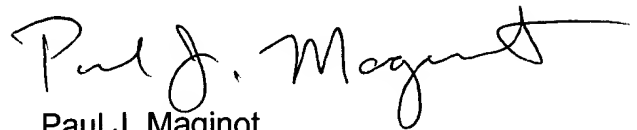
Claims 26-44 and 52-61 were rejected under 35 U.S.C. § 102(a) as being anticipated by a supplemental product flyer purportedly distributed by "Auto Meter Products, Inc." which was allegedly "printed before June 1999 as evidenced by the title 'New for '99'", and the statement in the middle of the page "Available in June!" (hereinafter "Auto Meter Flyer"). The attached letter indicates that Gauge Works, the supplier of the product in the flyer to Auto Meter, has a different belief regarding the phrase "Available in June!" At a minimum, this letter demonstrates that the flyer is so ambiguous regarding its date of publication that the Examiner cannot properly rely upon it as a ground of rejection under 102(a).

Applicant has demonstrated that the Examiner's ground of rejection should be reversed because (1) the Examiner has failed to prove that the flyer is a "printed publication" or evidence of "public knowledge or use" as required for anticipation under 35 U.S.C. § 102(a), (2) the Examiner failed to follow the rule set forth in CFR 1.105 regarding requests for information and the attendant safeguards of that rule have been circumvented by Examiner's reliance on unsubstantiated testimony regarding the Auto Meter Flyer, (3) the Examiner's solicitation for evidence from sources not approved by the MPEP have resulted in the exposure of information regarding the present invention that was subject to the secrecy restrictions imposed by 37 CFR 1.14, and (4) the Examiner has relied upon evidence that is capable of more than one interpretation. All of these factors demonstrate that the present *ex parte* proceeding has involved third

parties who are without the duty of candor imposed by Rule 56. Consequently, the Auto Meter Flyer should be given no weight in this Board's review of the final rejection. As no other art has been cited that supports Examiner's rejection, the rejection should be overruled and the claims allowed.

Respectfully submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, reading "Paul J. Maginot". The signature is fluid and cursive, with a long horizontal stroke extending from the end of the name.

Paul J. Maginot
Attorney for Appellant
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September 23, 2004

VIA FACSIMILE AND FIRST CLASS MAIL

Paul J. Maginot, Esq.
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Re: U.S. Patent Application Publication No. US2004/0056502

Dear Mr. Maginot:

We have now had an opportunity to consider your letter of September 9, 2004 with our client, Gauge Works, LLC (Gauge Works).

In your letter, you have represented your client's concerns and raised unfounded yet serious allegations vaguely directed at Gauge Works pertaining to the "Auto Meter flyer" used in supporting the U.S. Patent Office examiner's rejection of your client's above patent application. Reserving comment on the allegations in your letter, we have asked our client to provide any information it can pertaining to the Auto Meter flyer to perhaps assist in your inquiry for a specific date of public knowledge of this document or offer for sale of a product such as that represented in the flyer.

Our client and its employees cannot attest to an exact date when the Auto Meter flyer was first published. However, our client recalls that the flyer was produced and publicly circulated prior to the 1999 SEMA (Specialty Equipment Market Organization) Show in Las Vegas, Nevada, which was held on or about the first week of November, 1999. Our client also recalls that the flyer and a sample product as represented in the flyer were distributed and/or on public display at the same SEMA show. As our client's products are routinely displayed and advertised at the Auto Meter Products, Inc. (Auto Meter) booth at the annual SEMA show, our client and its employees were present at this 1999 show. Our client has further stated that the flyer appears to be an exact and legitimate copy of a flyer as published and displayed, as similar such flyers for a variety of products have been distributed at the annual SEMA shows and elsewhere for at least

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Paul J. Maginot, Esq.
September 23, 2004
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the last decade. With regard to the statement on the flyer, "Available in June", our client believes this statement indicated that the product was to become available in June, 2000. While our client believes part number, pricing and descriptive information about the product shown in the flyer were distributed at the 1999 show, our client does not believe Auto Meter accepted any orders for the product shown in the flyer at the 1999 show. If our client discovers any additional relevant information about the flyer, we will let you know.

In addition to the above, our client has now become aware of an instrument bezel part (No. 81101) offered for sale by Mitsubishi Motors Corporation (Mitsubishi) in the United States in 1999 as a part for the 2000 Mitsubishi Eclipse. According to vehicle assistance information available for the Mitsubishi Eclipse (available from Mitsubishi by calling 800-556-4878), this part is a factory instrument bezel which fits all model year Mitsubishi Eclipses since 2000, including the current year 2004 Mitsubishi Eclipse and the newly available 2005 Mitsubishi Eclipse. Further according to Mitsubishi, Mitsubishi routinely makes its next year Eclipse vehicles available in August or September of the previous year (i.e., the 2005 is currently available today, and the 2000 Eclipse was available in August, 1999), and parts are released four to five months ahead of the release of the vehicles. This practice is common among automobile manufacturers. Thus, for the 2000 Mitsubishi Eclipse, this instrument bezel would have been publicly available sometime in the spring of 1999.

In support of this, I enclose herewith copies of a part list and part specification sheet provided to my client by a local Mitsubishi dealer. The Eclipse instrument bezel is shown on the part specification sheet as part no. 81101. The part list printout for this part shows that this part was first available for sale at dealerships in the first third of the month of May, 1999. From our client's consultation with a Mitsubishi parts manager, the "99" in the encircled number 99051 means that the part was first available for purchase in 1999, the "05" signifies May of that year, and the "1" denotes the first third of that month.

I also enclose herewith copies of photographs of this instrument bezel from a 2003 Mitsubishi Eclipse, as taken by my client, showing the bezel with and without gauges retained in the lower openings. Again, Mitsubishi has confirmed that this part is the identical part as first made available in May, 1999 for the 2000 Eclipse. From a review of these photographs alongside the pending claims of your client's patent application, and with knowledge of the part's history and purpose, this instrument bezel clearly appears to constitute prior art material to the patentability of the claims of your client's above application. Given your duty and your client's duty under 37 C.F.R. 1.56, you and your client will undoubtedly wish to conduct a complete investigation of this bezel as you consider the proper action to take with the U.S. Patent Office (PTO).



WILLIAMS MULLEN

Paul J. Maginot, Esq.
September 23, 2004
Page 3

If, upon your review and investigation, you still believe your client is entitled to patent protection based on the disclosure and claims in the above patent application and you further believe that any claims read on one or more of my client's products, we would appreciate your outlining specifically which claims you feel read on which products manufactured by my client.

I trust that the above information will assist in your stated inquiry. If you have any further questions for my client surrounding the Auto Meter flyer, please continue to direct them to me.

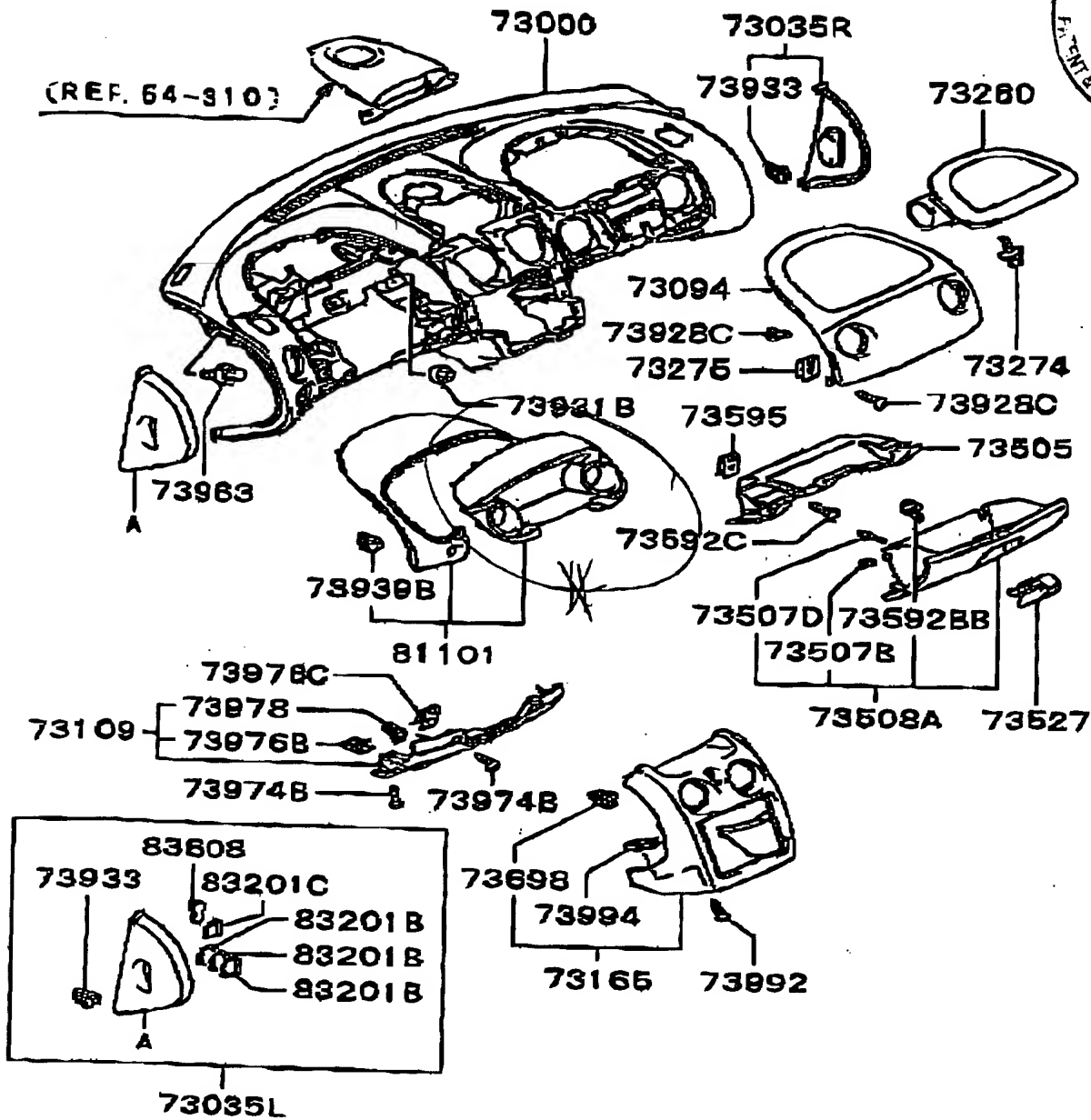
Very truly yours,

Thomas F. Bergert

TFB/emb
Enclosure

cc: Mr. Gregory Day, Gauge Works, LLC
Mr. George Russell, Auto Meter Products, Inc.

1085006.2



858AA7B

STOHLMAN MITSUBISHI
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Vienna, Virginia 22182



PART NUMBER SELECTION

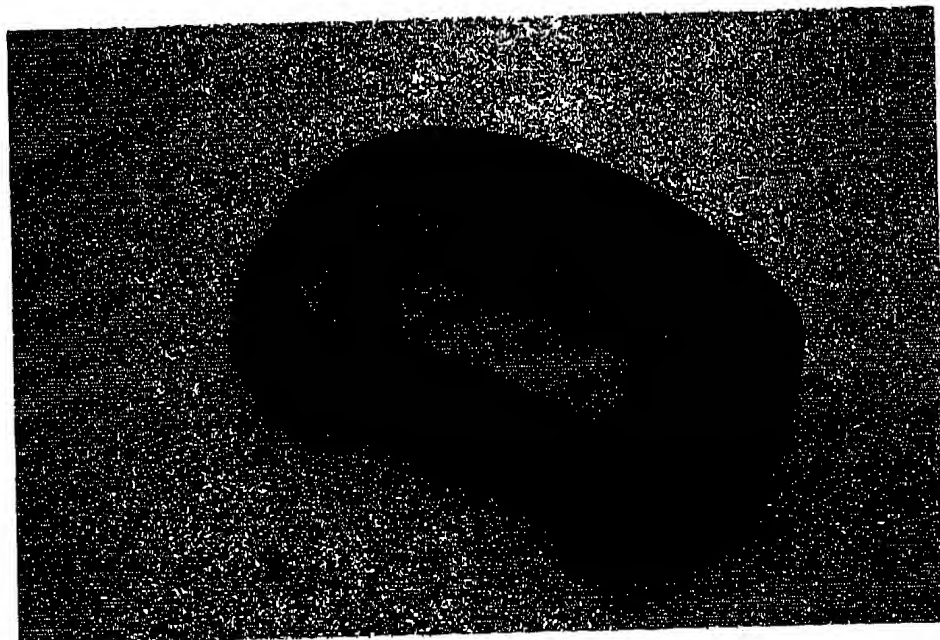
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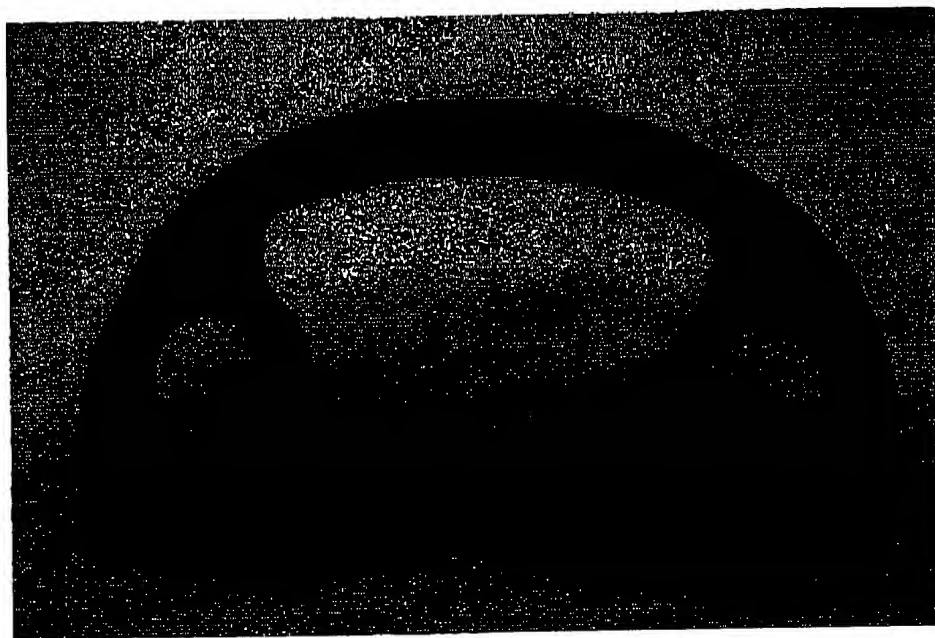
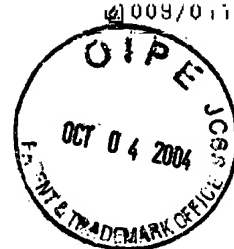
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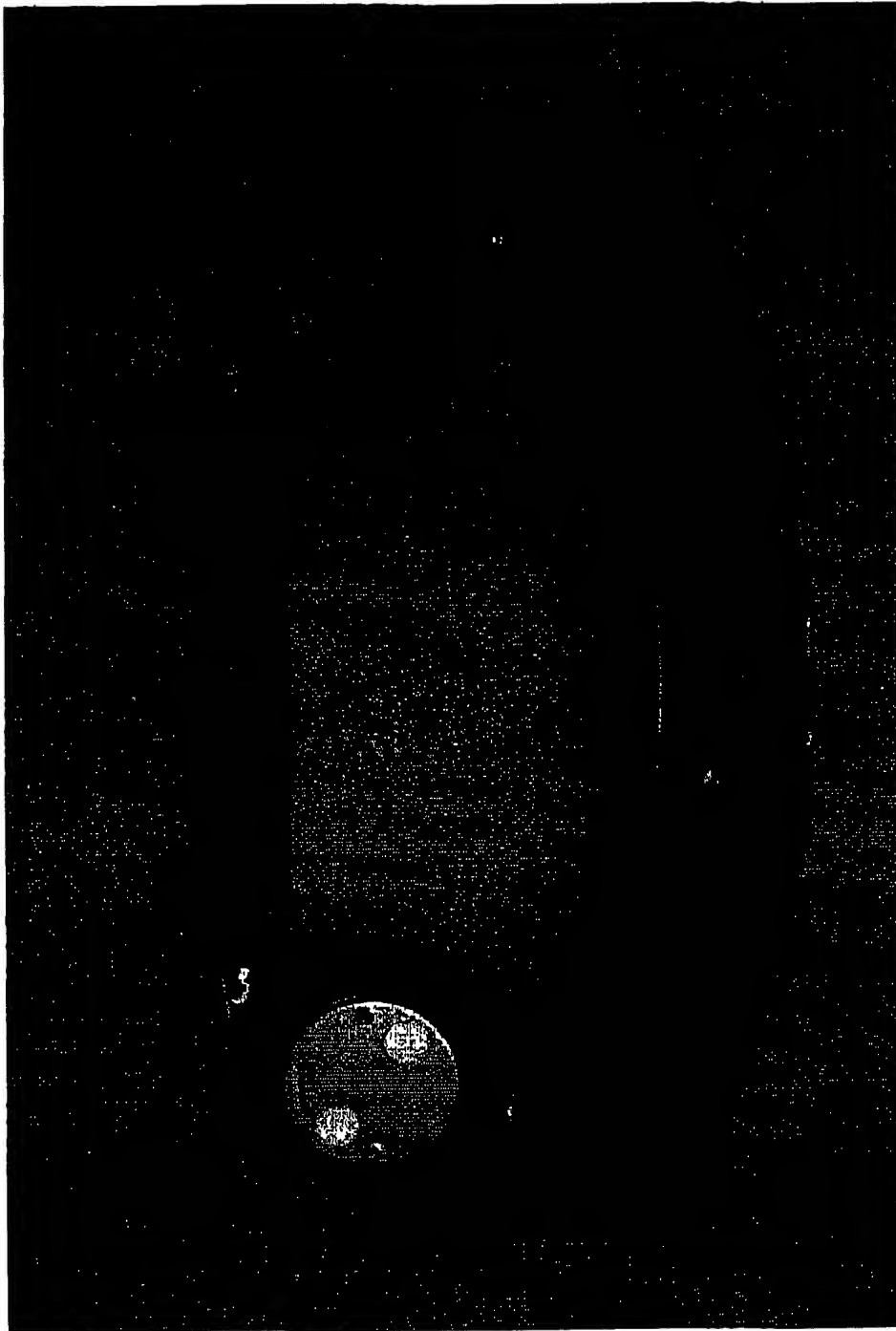
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